

REMARKS

These remarks are directed to the non-final office action mailed December 8, 2009. The office action issued by the Examiner and the citations referred to in the office action have been carefully considered.

Claims 1-12 are the pending claims being examined in the application, of which claims 1, 10, 11, and 12 are the independent claims.

Claims 1, and 10 to 12 have been amended. Claims 2 and 3 have been cancelled.

For the reasons set forth below, all pending claims are believed to be allowable, and such action is earnestly solicited. Reconsideration and further examination are respectfully requested.

Claim Rejections under 35 USC § 103

Claims 1 and 3 to 12 stand rejected under 35 USC §103(a) over Great Britain Patent No. GB 2,341,833 issued to Davison ("Davison") in view of U.S. Patent No. 6,098,335, issued to Brown, Jr. ("Brown"). Reconsideration and withdrawal of the rejections are respectfully requested for at least the following reasons.

The examiner's use of the single rail 20 of Davison to reject applicant's claims is respectfully traversed. As seen in Figs. 2 and 3, rail 20 does not show or suggest at least 2 longitudinal sections located apart and spaced from each other joined by link sections. This structure is present in all the independent claims and lends structural strength to the support members. This is not shown or suggested in Davison. Applicant's carriage is thus movable on the rail members and this is substantially different from Davison. Davison's gantry is movable on single rails 20, not on a rail system that is an integral part of a pair of spaced longitudinal sections joined by link systems along which the rail system extends. This is present in all independent claims and not shown or suggested in Davison alone or in view of Brown.

Accordingly it is submitted that the claims are not obvious over the cited art. The appropriate KSR standard and its progeny cases apply in dealing with the obviousness standard.

Although the teaching, suggestion, motivation test is still recognized under *KSR*, the test is largely subsumed by the more general principles laid out in *KSR*. Indeed, in any given application, the combination of elements “must do more than yield a predictable result.” *Id.* at 1740. Nevertheless, combining elements “in an unexpected and fruitful manner” is sufficient to render an invention non-obvious. *Id.*

More importantly, “a patent composed of several elements **is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.**” *KSR Id.* (emphasis added).

In *KSR*, the Supreme Court addressed such logic in obviousness-type rejections. Importantly, *KSR* specifically forbids obviousness rejections simply because each element was independently known in the prior art. The art cited against the instant application falls into this rubric because they are nothing more than a string of references showing some of the claimed elements with tenuous logic to support their combination.

Respectfully, the Examiner has failed in his burden to explain any compelling reason why a person of ordinary skill would have combined these references, and achieved the claimed invention. Indeed the teaching of the references suggest that they cannot be combined.

**No Reasonable Expectation of Success Can Be Inferred from the Combination of
References Asserted by the Examiner**

a. Reasonable Expectation Standard Reaffirmed Post-*KSR*

The Federal Circuit stated “obviousness does not require absolute predictability of success . . . [a]ll that is required is a reasonable expectation of success.” *In re O’Farrell*, 853 F.2d 894, 903-04; 7 U.S.P.Q.2d 1673 (Fed. Cir. 1988). Thus, if a reasonable expectation of success is derived from a reference or combination of references, an invention may be rendered

obvious. Conversely, where no reasonable expectation of success is derived, an obviousness rejection is improper. *Id.*

More specifically, *O'Farrell* provides general guidance as to when an invention falls under the reasonable expectation of success rubric, which was subsequently reaffirmed by the Federal Circuit post-*KSR* in *Pharmastem Therapeutics, Inc. v. Viacell, Inc.*, 491 F.3d 1342, 1364; 83 U.S.P.Q.2d 1289 (Fed. Cir. 2007). According to the Federal Circuit, “an invention would not be invalid for obviousness if the inventor would have been motivated ‘to **vary all parameters or try each of numerous possible choices until one possibly arrived at a successful result**, where the **prior art gave either no indication** of which parameters were critical or **no direction** as to which of many possible choices is likely to be successful.’” *Id.* at 1364, *quoting Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1165, 77 U.S.P.Q.2d 1865 (Fed. Cir. 2006) (emphasis added).

In a secondary test posited by the Federal Circuit in *Pharmastem*, the court stated “[l]ikewise, an invention would **not be deemed obvious if all that was suggested** ‘was to **explore a new technology or general approach** that seemed to be a **promising field of experimentation**, where the **prior art gave only general guidance** as to the particular form of the claimed invention or how to achieve it.’” *Id.*, *quoting Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1165, 77 U.S.P.Q.2d 1865 (Fed. Cir. 2006) (emphasis added).

b. No Reasonable Expectation of Success Where Numerous Possible Choices or Requirement to Vary All The Parameters

Using the first of the standards promulgated by the Federal Circuit, the combination of references cited by the Examiner against the claims have no reasonable expectation of success because the prior art references give no indication of critical parameters or direction as to how to achieve the claimed invention. Using any one of the prior art as the starting point to arrive at the claimed references cited against the instant application would require numerous choices in direction and experimentation, as well as variance of many parameters to arrive at the claimed invention.

For the reasons stated above, the prior art references cited against the claims also fail the second standard promulgated by the Federal Circuit. An invention is not obvious if all that was suggested is to explore a new technology or general approach that seemed to be a promising field of experimentation, where the prior art gave only general guidance as to the particular form of the claimed invention or how to achieve it. *Pharmastem* at 1364. In other words, the combination of references must give specific guidance to arrive at the claimed invention.

These prior art references alone do not even provide even general guidance to the instant problem and claimed solution.

In fact, the combination of these references makes sense **only** when viewed in the context of the specification and claims. Alone, they don't get a person of ordinary skill in the art any closer to an expectation of success because they simply don't have any guidance, even when combined, to guide a person of ordinary skill in the art to the claimed result without significant detective work.

Recently the Federal Circuit reaffirmed the obviousness standard in *Ortho-McNeil Pharmaceutical, Inc., v. Mylan Laboratories* as 520 F.3d 1358 at 1364 to 1365; 86 U.S.P.Q. 2d 1196 (Fed. Cir. 2008). The standard is quoted as follows:

Moreover this invention, contrary to Mylan's characterization, does not present a finite (and small in the context of the art) number of options easily traversed to show obviousness. The passage above in *KSR* posits a situation with a finite, and in the context of the art, small or easily traversed, number of options that would convince an ordinarily skilled artisan of obviousness. In this case, the record shows that a person of ordinary skill would not even be likely to start with 2,3:4,5 di-isopropylidene fructose (DPF), as Dr. Maryanoff did. Beyond that step, however, the ordinarily skilled artisan would have to have some reason to select (among several unpredictable alternatives) the exact route that produced topiramate as an intermediate. Even beyond that, the ordinary artisan in this field would have had to (at the time of invention without any clue of potential utility of topiramate) stop at that intermediate and test it for properties far afield from the purpose for the development in the first place (epilepsy rather than

diabetes). In sum, this clearly is not the easily traversed, small and finite number of alternatives that *KSR* suggested might support an inference of obviousness. *Id.* at 1742.

As this court has explained, however, a flexible TSM test remains the primary guarantor against a non-statutory hindsight analysis such as occurred in this case. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed.Cir.2007) (“[A]s the Supreme Court suggests, a flexible approach to the TSM test prevents hindsight and focuses on evidence before the time of invention.”). The TSM test, flexibly applied, merely assures that the obviousness test proceeds on the basis of evidence-teachings, suggestions (a tellingly broad term), or motivations (an equally broad term)-that arise before the time of invention as the statute requires.

As noted above, the challenges of this inventive process would have prevented one of ordinary skill in this art from traversing the multiple obstacles to easily produce the invention in light of the evidence available at the time of invention. .

The *KSR* Guidelines as applied to the instant application support inventiveness since the inventors have discovered and claimed the optimum structure as opposed to general structures. In analyzing these improved results, one is struck by the difference in kind attributable to invented structure, and logically the improvements could not flow equally well from changes in degree resulting from routine variation or experiment of the general conditions.

There was an almost limitless array of variables, and that the different view the correct sensitivity characteristics and the ranges are nearly infinite, and with the prior art did not provide any suggestion or motivation for one of ordinary skill in the art to contemplate an amount of the range. There was a lack of any credible teachings in the applied prior art itself which would appear to have fairly suggested the claimed subject matter as a whole to a person of ordinary skill in the art, or any viable line of reasoning as to why such artisan would have otherwise found the claimed subject matter to have been obvious in light of the teachings of the art. The prior art relied upon by the Examiner does not even recognize the problem addressed by the inventors of the present application, let alone suggest any of the claimed limitations.

The present invention is clearly non-obvious, and not the work of mere routine experiment. Here, the Examiner cannot meet the additional KSR threshold tests, since there are omissions from the cited references relative to the present claims, and the presently cited references teach against substitution or a combination. The Examiner therefore cannot show that there is a teaching, suggestion, or motivation to combine them and thereby attain the invention as claimed.

In the context of the relevant art, namely greenhouse construction, there are not a small number of limited options which could have been chosen or selected by a skilled artisan. Indeed, there were several unpredictable alternatives to determine the exact route for a successful greenhouse construction with a rail system for moving a carriage. It would only be with hindsight, which is not the standard for obviousness, to discount the number and complexity of the alternatives.

At the time of the invention, it was the inventors' insights and willingness to confront and overcome the obstacles which led to the invention as claimed.

Applicants, in the present application, submit that Examiner has failed to satisfy the burden of establishing that such an obstacle or problem exists. The Applicants went against conventional wisdom and provided a greenhouse construction with a rail system for moving a carriage, which is inventive in several different ways.

All of the independent claims now recite a specific greenhouse construction with a rail system for moving a carriage, and the prior art is silent as to many of the related operational characteristics. Applicants respectfully point out to the Examiner that the claimed limitations are not simply unimportant modifications without criticality.

The Applicants submit that a case of obviousness has not been established, and the Applicants submit that the prior art applied by the Examiner does not show the general conditions from which a greenhouse construction with a rail system for moving a carriage, as claimed, could be determined.

As such, Applicant submits that none of the cited references teach or suggest all of the elements and limitations of independent claims 1, 10, 11, and 12. Therefore, independent claims 1, 10, 11, and 12 as well as the claims dependent therefrom are patentable under 35 USC §103.


Conclusion

It is respectfully submitted that all of the Examiner's objections have been successfully traversed and that the application is now in order for allowance. Accordingly, reconsideration of the application and allowance thereof is courteously solicited.

The Director is authorized to charge any additional fee(s) or any underpayment of fee(s), or to credit any overpayments to **Deposit Account Number 50-2638**. Please ensure that Attorney Docket Number 072998-014400 is referred to when charging any payments or credits for this case.

Respectfully submitted,

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